

THE OFFICE ACTION

In the final Office Action issued on December 6, 2004, the Examiner rejected claims 1-6, and 8-14 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The Examiner also rejected claims 1-6, and 8-14 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter. The Examiner rejected claims 1, 3, 4, 8-11, 13-15, 17, 18, 22, 23, 25-27, 29 and 30 under 35 U.S.C. §103(a) as being unpatentable over Chapellier in view U.S. Patent No. 3,646,155 to Scott et al. (Scott). The Examiner also rejected claims 5, 6, 12, 19, 20 and 28 under 35 U.S.C. §103(a) as being unpatentable over Chapellier and Scott and further in view of either U.S. Patent No. 5,183,613 to Edwards (Edwards) or U.S. Patent No. 5,415,822 to Cook (Cook). The Examiner also rejected claims 1, 3-6, 8-15, 17-20, 22, 23, and 25-30 under 35 U.S.C. §103(a) as being unpatentable over Edwards in view of either one of Chapellier or Cook and further in view of Scott.

REMARKS

Applicants have carefully considered the final Office Action issued on December 6, 2004. Applicants respectfully request reconsideration of the application in light of the following comments.

A. Claims 1-6 and 8-14 Comply with 35 U.S.C. §112

The Examiner rejected claims 1-6 and 8-14 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Specifically, it is the Examiner's position that the specification fails to provide support for the recitation that the crosslinkable thermoplastic consists essentially of polyolefin. The Examiner also rejected claims 1-6, and 8-14 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter. Specifically, it is the Examiner's position that the term "essentially" is a relative term that renders the claim indefinite.

The Examiner first presented this rejection after the applicants' amended claim 1 to recite that the crosslinkable thermoplastic consisted essentially of polyolefin. The Examiner argued that this amendment constituted new matter. In the most recent office action, the Examiner stated, "Specifically, the specification

does not disclose any additional materials that that could be used in the crosslinkable thermoplastic that do not materially affect the basic characteristics of the crosslinkable thermoplastic.”

In several previous responses, Applicants have attempted to explain to the Examiner the inconsistencies in this rejection. As far as the Applicants can determine, the Examiner’s rejection is essentially based on the fact that the specification fails to disclose additional materials that can be included in the thermoplastic that DO NOT materially affect the characteristics of the thermoplastic.

Applicants submit that it is permissible to limit claims to a more narrow scope than the broadest embodiment in the specification. While it is true that amended claims cannot be broader than the original disclosure, the converse does not apply. That is, while the broadest description of the abrasion resistant layer in the specification does not exclude the possibility of additional components, it is perfectly within the Applicants’ rights to narrow the present claims to recite an abrasion resistant layer to a crosslinked thermoplastic consisting essentially of a polyolefin.

As noted in *Water Technology Corp. v. Calco, Ltd.*, 7 USPQ2d 1097 (Fed. Cir. 1988), the phrase “consisting essentially of” does not exclude the addition of another ingredient which does not materially affect the characteristics of the invention. This is explained further in *PPG Industries v. Guardian Industries Corp.*, 48 USPQ2d 1351 (Fed. Cir. 1998), which held that “by using the term ‘consisting essentially of’, the drafter signals that the invention necessarily includes the **listed** ingredients and is open to **unlisted** ingredients that do not materially affect the basic and novel properties of the invention.” Thus, a specification does not need to recite ingredients that do not affect the properties of the invention in order to claim a compound using the transition phrase “consisting essentially of”. Rather, the use of this phrase means that the invention necessarily includes the listed ingredients and may include any additional ingredients that do not affect the property of the invention, ***irrespective of whether these additional ingredients are listed in the specification or not.***

In the present case, Applicants are not required to list any material that could possibly be included in the crosslinkable thermoplastic, including those materials that DO NOT affect its material characteristics. An almost limitless number

of contaminants and additives may be included in the present crosslinkable thermoplastic. Applicants are not required to list all of these to be entitled to use the claim language “consisting essentially of...”

Although the specification does not recite additional materials for use in the crosslinkable thermoplastic, it also does not preclude the possibility of additional materials. This is important. The fact that any additional materials not affecting the material characteristics of the thermoplastic are not listed does not mean that those materials cannot be present. It is perfectly within the Applicants' rights to narrow the present claims to recite an abrasion resistant layer to a crosslinked thermoplastic consisting essentially of a polyolefin, which may also include unnamed components that do not affect the properties of the invention.

To highlight the inconsistency of the Examiner's opinion, Applicants point to the Examiner position in the final office action and the advisory action. In the final office action and in support of the present rejection, the Examiner stated, “[I]t is unclear where in the specification the crosslinkable thermoplastic is described as ‘consisting essentially of polyolefin’. It is noted the specification does disclose the crosslinkable thermoplastic as ‘comprising a polyolefin’.” Based on this statement, it would follow that the Examiner would have had no problem if the amendment read “comprising polyolefin”. Similarly, in the quotation from the advisory action cited above, the Examiner notes that no additional materials besides polyolefin are disclosed. Based on this, the Examiner would also apparently have had no problem if the amendment had been made to read “consisting of polyolefin.” Based on this, the Examiner's rejection of the phrase “consisting essentially of”, which is of intermediate scope between the broad “comprising” and the relatively narrow “consisting of” language, is illogical. How can both a broader and narrower scope be acceptable while an intermediate scope is not? This only highlights the inconsistency of the Examiner's position.

B. The Pending Claims Are Not Obvious Over Chapellier in View of Scott

The Examiner rejected claims 1, 3, 4, 8-11, 13-15, 17, 18, 22, 23, 25-27, 29 and 30 under 35 U.S.C. §103(a) as being unpatentable over Chapellier in view of Scott. Applicants respectfully traverse for at least the following reasons.

First, there is no motivation to combine Chapellier with Scott. The Examiner states that it would have been obvious to combine Chapellier with Scott as Scott discloses a technique for crosslinking polyolefins wherein less critical crosslinking conditions are required. Applicants submit that crosslinking using silane grafting techniques are at least as "critical" as other crosslinking techniques, including peroxide crosslinking. Applicants submit that the presence of a steam bath and the requirement of the silane graft present additional process steps and considerations and constitute conditions that are at least as critical as other techniques.

Second, even if the references could be combined, they would still not disclose or suggest all of the elements of the present claims. As Chapellier clearly discloses, the process calls for depositing a film of crosslinked polyethylene on the mounting surface of the extruded weather strip (claim 1, also see page 2 of translation). Thus, the polyethylene is already crosslinked *prior* to contacting it with the weather strip. This is in contrast to the present claims, which recite at least partially crosslinking the thermoplastic *after* extruding it onto the elastomer rubber. This was elected in response to a restriction requirement earlier in prosecution. Thus, any proposed combination of Chapellier and Scott fails to disclose or suggest such a process. Applicants request withdrawal of this rejection.

C. The Pending Claims are not Obvious Over Chapellier in view of Scott and further in view of Edwards or Cook

The Examiner further rejected claims 5, 6, 12, 19, 20 and 28 under 35 U.S.C. §103(a) as being unpatentable over Chapellier and Scott and further in view of either Edwards or Cook. Applicants respectfully traverse.

The Examiner states that Chapellier and Scott teach all of the limitations except for the specific times and temperatures for extruding and curing the thermoplastic and the elastomer and the specific rubber of the main body member and that Edwards and/or Cook teach such limitations. The Examiner cites Edwards and Cook as teaching the use of EPDM rubber and the claimed times and temperatures. As detailed above with respect to section B, the proposed combination of Scott and Chapellier fails to disclose or suggest a process wherein the polyolefin is at least partially cured after being extruded onto the elastomer

rubber. Since the rejected claims depend from those discussed above and contain all of the limitations therein, even assuming the propriety of combining Chapellier and Scott with either Edwards or Cook, such a combination would still not disclose or suggest all of the limitations of the present claims.

D. The Pending Claims are Not Obvious Over Edwards in View of Either Chapellier or Cook and Scott

1, 3-6, 8-15, 17-20, 22, 23, and 25-30 under 35 U.S.C. §103(a) as being unpatentable over Edwards in view of either one of Chapellier or Cook and further in view of Scott. Applicants respectfully traverse.

First, and with respect to the combination of references, there is no motivation to combine the teachings of Edwards with either Chapellier or Cook. As detailed in the response to the previous office action, to properly combine references under 35 U.S.C. §103, there must be some suggestion or motivation to modify or combine reference teachings (MPEP §2143.01). With respect to a proposed combination of Edwards and Chapellier or Cook, the Examiner states, "It would have been obvious to one of ordinary skill in the art at the time the invention was made to use as the polyolefin as taught by Edwards any well known and conventional polyolefin such as a crosslinkable polyolefin...as shown for example by either one of Chapellier or Cook". In this respect, Applicants submit that a crosslinkable polyolefin is not a "conventional" polyolefin. Conventional polyolefins such as polyethylene, polypropylene, etc., are conventionally *not* crosslinked.

Applicants submit that, despite the Examiner's arguments, one skilled in the art would not have readily appreciated using a crosslinkable polyolefin as the polyolefin taught by Edwards. In support of his position, Examiner states "it is noted Edwards is directed to using general polyolefins known to one in the art, and Edwards is not limited to any particular, i.e. crosslinkable or non-crosslinkable, polyolefin. (Office Action, pg. 10).

Applicants submit that this is a mischaracterization of the materials and that such a substitution is not as straightforward as the Examiner would have it seem. In this respect, applicants take issue with the Examiner's contention that because Edwards does not explicitly disclose that the polyolefins used therein are uncrosslinked, that a crosslinked polyolefin is contemplated and could thus be used.

The Examiner will appreciate that due to absence of unsaturation, conventional polyolefins are not crosslinked or crosslinkable by ordinary means. That is, polyolefins require specialized crosslinking techniques due to this absence of double bonds in the polymer backbone. To one skilled in the art, the use of the term "polyolefin" denotes a conventional uncrosslinked polyolefin. A positive recitation of crosslinking is required to denote a specialized crosslinkable polyolefin. It is improper and misleading for the Examiner to thus contend that Edwards supports the use of crosslinked polyolefins without any positive recitation of this.

The Examiner attempts to counter this argument by noting that no declaration or affidavit supporting this contention has been filed and that "Chapellier and Cook are both exemplary of the use of a crosslinkable thermoplastic polyolefin with the same art as Edwards for the same abrasion resistance layer such that clearly one skilled in the art would not limit the use of the term "polyolefin" to only uncrosslinked polyolefin."

Applicants have argued previously that Cook does not disclose the use of crosslinked polyolefins, but only crosslinked polyolefin blends with rubber (e.g. Santoprene as specifically discussed in Cook). Applicants readily admit that Chapellier discloses the use of crosslinked polyolefin as an abrasion resistance layer, but the Examiner will note that Chapellier clearly discloses that the polyolefin is crosslinked. If the applicant in Chapellier thought that a general disclosure of polyolefin encompassed crosslinked polyolefins, then there would have been no need to explicitly state that the polyolefin was crosslinked in that application. Applicants assume the Examiner would not argue that Chapellier discloses the use of crosslinked polyolefin unless it specifically stated that the polyolefin was crosslinked, so how can he say that about Edwards? That is, by specifically stating that the polyolefin is crosslinked, Chapellier is strong evidence that the general term polyolefin does not encompass crosslinked polyolefins.

Even assuming for the purposes of argument that one skilled in the art would have appreciated that a crosslinkable polyolefin could have been used in the invention of Edwards, the absence of any motivation to do so precludes the finding of obviousness.

In this respect, the mere fact that a prior art device could be modified so as to produce the claimed invention is not a basis for an obviousness rejection

unless the prior art suggested the desirability of such a modification. *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984) (the combination of the references taught every element of the claimed invention. However, without a motivation to combine a rejection based on a *prima facie* case of obviousness is improper.) Here, the Examiner has not provided any reasons why one skilled in the art would be motivated to combine the teachings of Cook and Edwards. At most he has provided an argument that one skilled in the art recognized that such a combination is possible. A recognition that something can be done is distinct from a motivation to do it. Absent such a suggestion or motivation, the Examiner's combining of the two references is a classic example of impermissible hindsight reconstruction. *Texas Instruments, Inc. v. U.S. Int'l Trade Comm'n*, 26 USPQ2d 1018 (Fed. Cir. 1993). Conclusory statements on the propriety of combining the teachings of prior art references, such as those provided by the Examiner in this case, are insufficient to sustain an obviousness rejection. *In re Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002).

In addition, Cook relates to a method of forming a composite extrusion in which an elastomer rubber main body member is cured prior to mating with a thermoplastic layer, while Edwards specifically teaches curing the elastomeric substrate after contacting it with the melted polyolefin compound (col. 5, lines 52-60, claim 1). These two references are drawn to different processes to making composite extrusions. One skilled in the art practicing the invention of Edwards would not be motivated to use the teachings disclosed in Cook since Cook relates to a different process, and there is no indication that these teachings would be suitable for use therein. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 123 USPQ 349 (CCPA 1959). Here, that is exactly what the Examiner is proposing – changing the principle of operation of the references in an attempt to meet the recitations of the present claims. Thus, Cook cannot be combined with Edwards.

With respect to a proposed combination of Edwards and Chapellier, Chapellier discloses crosslinking the polyolefin prior to extruding it onto the elastomer rubber. Thus, even assuming the propriety of combining Edwards with Chapellier, such a combination would not disclose or suggest the present process of

crosslinking the polyolefin after contacting it with the elastomer rubber. Thus, any proposed combination of Edwards, Chapellier and Scott would not render the present claims unpatentable.

CONCLUSION


In view of the foregoing comments, Applicants submit that claims 1, 3-6, 8-15, 17-20, 22, 23 and 25-30 are in condition for allowance. Applicants respectfully request early notification of such allowance. Should any issues remain unresolved, the Examiner is encouraged to contact the undersigned to attempt to resolve any such issues.

If any fee is due in conjunction with the filing of this response, Applicants authorize deduction of that fee from Deposit Account 06-0308.

Respectfully submitted,

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